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OFFICE OF PETITIONS

In re Application of

Khanuja, et al.

Application No. 10/822,790

Filing Date: 13 April, 2004

Attorney Docket No. 033166-028

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DECISION ON PETITION

This is a decision on the petition filed on 30 September, 2004, to obtain a filing date of 13 April, 2004, for the instant application.

For the reasons set forth below, the petition is **GRANTED**.

BACKGROUND

This nonprovisional application was deposited on 13 April, 2004.

On 7 July, 2004, the Office mailed a "Notice of Incomplete Nonprovisional Application," (the 7 July Notice) and indicated that a filing date had not been granted because the application had been deposited without drawings as required under 35 U.S.C. §113 (first sentence).

The 7 July Notice also informed Petitioner that the application would receive the filing date consistent with the submission of required drawings, or that Petitioner might evidence that either drawings were not necessary for the understanding of the invention or the application as submitted otherwise satisfied the statutory requirements for a filing date.

Petitioner:

- filed the original petition on 13 August, 2004, alleging therein that the instant application incorporated by reference the parent such that the presence of the drawing in the parent

with the incorporation by reference of that disclosure satisfied the statutory requirement, however, Petitioner failed to file with that petition a copy of the parent application, incorporated by reference, as filed, and so the petition was dismissed on 21 September, 2004;

- with the instant petition, filed 30 September, 2004, Petitioner has supplied a copy of the parent Application 10/135,763 alleged to have been incorporated by reference with a complete specification as part of the original disclosure, along with a copy of the receipt card from that filing (Specification p. 1 - 16, Claims p. 17 - 20, Abstract 1 page (unnumbered), Fig 1 (1 page)).

A search of the official file reveals that on 13 April, 2004, a "Utility Patent Application Transmittal" letter was filed which itemized the filing of a declaration and preliminary amendment. The transmittal letter states that the application is a divisional of Application No. 10/135,763, and that the entire disclosure from the prior application is incorporated by reference.

Based on petitioners' representation that the papers supplied with the petition constitute a copy of the "complete specification" of the prior application, and the incorporation by reference statement appearing on the transmittal letter deposited on 13 April, 2004, stating that the entire disclosure of prior application (identified as Application No. 10/135,763) on the transmittal letter was incorporated by reference in the present application on 13 April, 2004, it appears that the specification was present in the Office on 13 April, 2004, albeit in the file of another application, *i.e.*, Application No. 10/135,763. Therefore, on petition, the application may be accorded the requested filing date.

(Although, while Petitioner has not alleged, alleging, *inter alia*, that the drawings omitted were "not *** necessary for the understanding of the subject matter sought to be patented," a review of the application also indicates that, *inter alia*, the application contains one or more methods and/or process claims (*e.g.*, Claim 17). It is the practice of the Office to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for the understanding of the invention under 35 U.S.C. §113 (first sentence). (See: MPEP §601.01¹) This application contains method claims, *e.g.*, claim 17. Therefore, the

¹ The commentary at MPEP §601.01 provides in pertinent part:

601.01(f) Applications Filed Without Drawings

35 U.S.C. 111(a)(2)(B) and 35 U.S.C. 111(b)(1)(B) each provide, in part, that an "application shall include . . . a drawing as prescribed by section 113 of this title" and 35 U.S.C. 111(a)(4) and 35 U.S.C. 111(b)(4) each provide, in part, that the "filing date . . . shall be the date on which . . . any required drawing are received in the Patent and Trademark Office." 35 U.S.C. 113 (first sentence) in turn provides that an "applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented."

Applications filed without drawings are initially inspected to determine whether a drawing is referred to in the specification, and if not, whether a drawing is necessary for the understanding of the invention. 35 U.S.C. 113 (first sentence).

It has been USPTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence). The same practice has been followed in composition

application should have been treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP §601.01(g).²

Based on petitioners' representation that the papers supplied with the petition constitute a copy of the "complete specification" of the prior application, and the incorporation by reference statement appearing on the transmittal letter deposited on 13 April, 2004, stating that the entire disclosure of prior application (identified as Application No. 10/135,763.) on the transmittal letter was incorporated by reference in the present application on 18 September, 2003, it appears that the specification was present in the Office on 13 April, 2004, albeit in the file of another application, *i.e.*, Application No. 10/135,763. Therefore, on petition, the application may be accorded the requested filing date.

The application will be processed and examined with the 21 pages of specification, including claims and abstract, and 1 sheet of drawings supplied on 21 September, as a part of the original disclosure.

The petition is granted. Since the petition was required to accord the requested filing date, the petition fee of \$130.00 will not be refunded.

applications.

* * *

A nonprovisional application having at least one claim, or a provisional application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, not describing drawing figures in the specification, and filed without drawings will simply be processed for examination, so long as the application contains something that can be construed as a written description. A nonprovisional application having at least one claim, or a provisional application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, describing drawing figure(s) in the specification, but filed without drawings will be treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP § 601.01(g), so long as the application contains something that can be construed as a written description. In a situation in which the appropriate Technology Center (TC) determines that drawings are necessary under 35 U.S.C. 113 (first sentence) the filing date issue will be reconsidered by the USPTO.

* * *

² The commentary at MPEP §601.01 provides in pertinent part:

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601.01(g) Applications Filed Without All Figures of Drawings

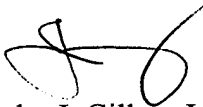
The Office of Initial Patent Examination (OIPE) reviews application papers to determine whether all of the figures of the drawings that are mentioned in the specification are present in the application. If the application is filed without all of the drawing figure(s) referred to in the specification, and the application contains something that can be construed as a written description, at least one drawing, if necessary under 35 U.S.C. 113 (first sentence), and, in a nonprovisional application, at least one claim, OIPE will mail a "Notice of Omitted Item(s)" indicating that the application papers so deposited have been accorded a filing date, but are lacking some of the figures of drawings described in the specification. The mailing of a "Notice of Omitted Item(s)" will permit the applicant to either: (1) promptly establish prior receipt in the USPTO of the drawing(s) at issue (generally by way of a date-stamped postcard receipt (MPEP § 503)); or (2) promptly submit the omitted drawing(s) in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the drawing(s) was in fact deposited in the USPTO with the application papers must, within 2 months from the date of the "Notice of Omitted Item(s)," file a petition under 37 C.F.R. 1.53(e) with the petition fee set forth in 37 C.F.R. 1.17(h), along with evidence of such deposit (37 C.F.R. 1.181(f)). The petition fee will be refunded if it is determined that the drawing(s) was in fact received by the USPTO with the application papers deposited on filing.

* * *

Of course, the primary examiner is expected to compare the specification supplied on 21 September, 2004, to the disclosure of prior Application No. 10/135,763 in order to verify that the specification is, in fact, part of the disclosure of the prior application.

The application is being forwarded to the Office of Initial Patent Examination for correction of the filing date to 13 April, 2004, using the application papers filed on that date and the 21 pages of specification and claims, including one (1) page of abstract, and 1 sheet of drawings supplied with the present petition, as the original disclosure, and for an indication in Office records that 1 sheet of drawings were present on filing.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.

A handwritten signature in black ink, appearing to read 'J. Gillon, Jr.', with a stylized flourish at the end.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions